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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,185	12/15/2003	Nobuo Sugino	F-8064	4336
28107 7590 05/24/2007 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT 1734	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/736,185

Applicant(s)

SUGINO, NOBUO

Examiner

Kimberly K. McClelland

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


KKM

Response to Arguments

1. Applicant's arguments filed 5/8/07 have been fully considered but they are not persuasive.
2. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
3. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
4. With respect to applicant arguments against the rejection of claims 3, 2, 13, 15-16, 29, and 37, examiner disagrees with this position. Since the adhesive used in Collins the same type used by applicant, it stands to reason, the adhesive would have the same property. While, Collins does not explicitly talk about the surface tension of the adhesive, it is implicit in the type of adhesive used and in the manner that Collins is using the adhesive. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610,613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d

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731,739,218 USPQ 769, 775 (Fed. Cir. 1983). Surface tension, the ability to be colored, flexibility, straining properties, and overlayability are inherent substance properties.

Therefore, if the adhesive used in the references is the same as that disclosed by applicant, then it is inherent that the surface tension would be the same.

5. As to applicant's arguments that Collins does not disclose applying adhesive to the second surface of the pattern. Collins reads on the invention as disclosed in claims 39 are follows: providing a liner sheet (i.e. support film; column 3, lines 6-13); applying a remover layer on said liner sheet to form a transfer sheet comprising said liner sheet and said remover layer, said remover layer being in direct contact with said liner sheet (i.e. coated papers, column 3, lines 14-15); forming a pattern on said remover layer (i.e. support film/remover layer) by copying or printing, said pattern comprising a first surface being in direct contact with said remover layer (column 3, lines 18-19); applying an adhesive to a second surface of said pattern (i.e. surface facing away from support film; column 5, lines 31-37); contacting said adhesive to a substrate and applying heat or pressure to said transfer sheet (i.e. transparent or translucent sheet; column 1, line 67-column 2, line 2); removing said transfer sheet from said pattern to thereby leave said adhesive and said pattern on said substrate (i.e. stripped away; column 2, lines 2-4).

Examiner asserts the adhesive coated on the second surface of the pattern is in contact with the substrate during lamination, as shown in Collins.

6. In response to applicants arguments that Collins cannot coat a first surface of the pattern. Examiner disagrees. Collins discloses transferring the pattern to a transfer

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sheet; wherein the first surface is facing upwards after initial transfer. Collins discloses transferring a protective coating (i.e. colored background layer) on the first surface.

7. As to applicants arguments against claims 13 and 15, in response to applicant's argument that the brushed layer is not adhesive, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Edwards teaches it is known to apply coatings with a brush. The composition of the coating does not affect known coating techniques.

8. As to claim 29, the temporary sheet of Collins, not the final transparent substrate acts, reads on the substrate of the current invention. The adhesive of Collins contacts the transfer sheet.

9. With respect to claim 31, Collins discloses coated paper may be used as a support film. The coating on the paper is the remover layer.

10. As to claim 32, in response to applicant's argument that the sprayed layer is not adhesive, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981). Edwards teaches it is known to apply coatings by spraying.

The composition of the coating does not affect known coating techniques.

11. In response to applicant's arguments against claim 37 and 38, the "consisting of" language of claims 37 and 38 does not prevent further steps from being performed after the claimed process, such as hanging a sign, lighting a sign, and taking down a sign.

The intermediate article disclosed by Collins meets applicant's currently claimed invention, not the finally transferred article. The intermediate article of Collins has an independent utility, such as being capable of being transported to separate locations for further processing.

12. Regarding claims 19-20, applicant argues there is no reason to use white paint in the adhesive of Collins. Takahara discloses it is well known in the art to provide brighter images by using white pigment in the background layer. The disclosure of Collins to remove the adhesive layer is optional (i.e. preferably/if). Consequently, Takahara does not teach away from Collins.

13. As to Applicant's arguments that the adhesive of Takahara is of a higher strength than that disclosed by Collins, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The strength of the transfer adhesive does not alter the brightness improvement white pigment provides.

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14. As to applicant's argument that Werner does not disclose overtransferring, applicant is directed to column 1, lines 1-2 of Werner (i.e. multi-color prints).

15. In response to applicant's argument that Werner does not disclose resin toner, applicant is directed to column 1, lines 36-42, which disclose printings colors.

16. As to applicants arguments against combining an iron with the method of Werner, examiner disagrees. It is noted irons are not limited to the size and shape of that provided by applicant, and in general are capable of meeting a wide range of pressure requirements.

17. As to applicant's arguments that the adhesive of Takahara would not work with Werner, it is noted both adhesives are used in thermal image transfer. Consequently, examiner expects similarly employed adhesives to be interchangeable. As a result, there is sufficient expectation for success.

18. In response to applicant's argument that a remover sheet may not be a coating, examiner disagrees. A coated layer on a substrate, once dried, meets applicant's claimed remover sheet. Applicant's drawing and specification are not read into the claims.

Consequently, Applicant's arguments are not persuasive, and the rejection is maintained.



CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER

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